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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
Edwards et al. :
Application. No. 09/965,654 : Group Art Unit: 1631
Filed: September 27, 2001 : Examiner: Michael L. Borin
For: Protein Data Analysis : Docket No.: IPT-002.02

CERTIFICATE OF FIRST CLASS MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail, postage prepaid, in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

November 4, 2004
Date of Signature
and of Mail Deposit

Shirine Darvish
Shirine Darvish

**PETITION FOR REVIVAL OF ABANDONED APPLICATION
UNDER 37 C.F.R. §1.137(b)**

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition to revive the above-identified patent application. Although a Notice of Abandonment has **NOT** been received, pursuant to 37 C.F.R. §1.137(b), Applicants declare:

1. The subject Application was filed on September 27, 2001;
2. The Patent Application Transmittal filed on September 27, 2001 included a reference to Customer Number 25181 for Foley Hoag, LLP;

3. All subsequent papers filed in association with the above referenced application included a reference to Customer Number 25181 for Foley Hoag, LLP;

4. Over Memorial Day Weekend 2002 (May 25-27, 2002) Foley Hoag, LLP moved their offices from One Post Office Square, Boston, MA 02109-2170 to 155 Seaport Boulevard, Boston, MA 02110-2600;

5. On May 29, 2002, David A. Lane (Reg. No. 39,261) filed a Request for Customer Number Data Change for Customer Number 25181 to change the correspondence address of Foley Hoag, LLP to 155 Seaport Boulevard, Boston, MA 02110-2600 (see Attachment A). In accordance with MPEP §403 and 711.03(c)(II)(C)(2) the Customer Number may be used to change the correspondence address for a list of applications and/or patents. Furthermore, any inconsistencies between the correspondence address resulting from a Customer Number being provided in an application for the correspondence address and any other correspondence address provided in that application should be resolved in favor of the address of the customer number (see MPEP §403).

6. On July 24, 2002 the United States Patent and Trademark Office mailed a Notice of Customer Number Record Change for Customer Number 25181 indicating that the correspondence address for Foley Hoag, LLP had been changed to 155 Seaport Boulevard, Boston, MA 02110-2600 (See Attachment B);

7. On February 11, 2004, Applicants filed a Status Inquiry including a reference to Customer Number 25181;

8. On March 22, 2004 a Restriction Requirement was mailed to the old correspondence address for Foley Hoag, LLP (e.g., One Post Office Square, Boston, MA 02109-2170). The envelope containing the Restriction Requirement was returned to the United States Patent and Trademark Office and received at Tech Center 1600/2900 on April 13, 2004 (see Attachment C). This document was never received by Foley Hoag, LLP;

9. On September 23, 2004, Theresa Bresnahan, Foley Hoag, LLP's Patent Docketing Administrator, checked the status of the above-referenced application on the PAIR website during a routine status check. Ms. Bresnahan printed copies of the Restriction Requirement that had been mailed on March 22, 2004 but never received by Foley Hoag, LLP and the documentation relating to the envelope which had been returned to the United States Patent and Trademark Office on April 13, 2004 from the Image File Wrapper on the PAIR website (see Attachment C);

10. On or about October 22, 2004, the undersigned contacted Examiner Borin about the status of the above referenced application and the incorrect correspondence address associated with the application. Examiner Borin requested that the undersigned submit a petition to revive the above-referenced application along with a response to the outstanding restriction requirement that had been obtained from the Image File Wrapper on PAIR.

11. In accordance with 37 CFR 1.137(b), Applicants' Attorney provides:

a. In accordance with 37 CFR 1.137(b)(1), a Response to the Restriction Requirement dated March 22, 2004 is enclosed herewith;

b. In accordance with 37 CFR 1.137(b)(2) and 1.17(m), please charge the petition fee of \$685.00 based on a small entity status to our **Deposit Account No. 06-1448**;

c. In accordance with 37 CFR 1.137(b)(3), Applicants' Agent states that the entire delay in filing the enclosed Reply was unintentional based upon the facts declared in paragraphs 1-10 herein. A Notice of Abandonment has **NOT** been received.

It is thus respectfully petitioned and requested that the subject Application be revived, that the enclosed Response to Restriction Requirement be entered, and that the subject Application be processed for Examination.

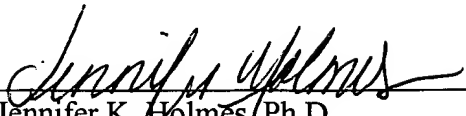
Although we believe that we have appropriately provided for any fees due in connection with this submission, the Commissioner is authorized to credit any overpayment or charge any deficiencies to/from our **Deposit Account No. 06-1448**.

If any questions remain, or any additional information is needed, Applicants' Agent respectfully requests a telephone call to the undersigned.

U.S.S.N.: 09/965,654

Respectfully submitted,

Dated: November 4, 2004


Jennifer K. Holmes, Ph.D.
Agent for Applicants
Registration No. 46,778

Customer No: 25181
Patent Group
Foley, Hoag, LLP
155 Seaport Blvd.
Boston, MA 02210-2600

Enclosures

JOB STATUS REPORT

TIME : 05/29/2002 14:44
NAME : FOLEY HOAG LLP
FAX# : 617-832-7000
TEL# :

DATE, TIME	05/29 14:43
FAX NO./NAME	917033082840
DURATION	00:01:04
PAGE(S)	03
RESULT	OK
MODE	STANDARD ECM



**FOLEY
HOAG** LLP
ATTORNEYS AT LAW

Fax

Date: May 29, 2002

To: Stacy Fuller

Fax #: 1-703-308-2840

Confirm#:

Client Matter#: 90005-408

Therese Galante

From: Patent Administrator

Sender's Number: 1763

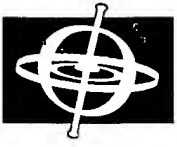
User #: 1627

Total Pages Sent (Including Cover Sheet): 3

Office: Boston

Message

please see the attached Customer Number Data Change which lists our new firm name and our new address.



**FOLEY
HOAG** LLP
ATTORNEYS AT LAW

Fax

Date: May 29, 2002

To: Stacy Fuller

Fax #: 1-703-308-2840

Confirm#:

Client Matter#: 90005-408

Therese Galante

From: Patent Administrator

Sender's Number: 1763

User #: 1627

Total Pages Sent (Including Cover Sheet): 3

Office: Boston


Message

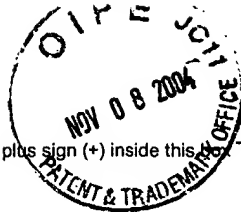
please see the attached Customer Number Data Change which lists our new firm name and our new address.

IMPORTANT – PLEASE READ

THE INFORMATION CONTAINED IN THIS FACSIMILE MESSAGE IS INTENDED ONLY FOR THE PERSONAL AND CONFIDENTIAL USE OF THE DESIGNATED RECIPIENTS NAMED ABOVE. THIS MESSAGE MAY BE AN ATTORNEY-CLIENT COMMUNICATION AND AS SUCH IS PRIVILEGED AND CONFIDENTIAL. IF THE READER OF THIS MESSAGE IS NOT THE INTENDED RECIPIENT OR AN AGENT RESPONSIBLE FOR DELIVERING IT TO THE INTENDED RECIPIENT, YOU ARE HEREBY NOTIFIED THAT YOU HAVE RECEIVED THIS DOCUMENT IN ERROR, AND THAT ANY REVIEW, DISSEMINATION, DISTRIBUTION OR COPYING OF THIS MESSAGE IS STRICTLY PROHIBITED. IF YOU HAVE RECEIVED THIS COMMUNICATION IN ERROR, PLEASE NOTIFY US IMMEDIATELY BY TELEPHONE AND RETURN THE ORIGINAL MESSAGE TO US BY MAIL. THANK YOU.

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Please type a plus sign (+) inside this 



PTO/SB/124A (08-00)

Approved for use through 10/31/2002. OMB 0651-0035
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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Request for Customer Number Data Change

Address to:

Commissioner for Patents
Box CN
Washington, DC 20231

To the Commissioner of Patents and Trademarks:

Please record the following data changes to **Customer Number**:

Type **Customer Number** here

25181

Place **Customer Number**
Bar Code Label here

☒ Please change Correspondence Address to:

Firm or Individual Name	Foley Hoag LLP				
Address	Patent Group				
Address	155 Seaport Boulevard				
City	Boston	State	MA	ZIP	02110
Country					
Telephone	617-832-1230	Fax	617-832-7000		

☒ Please delete the following practitioner registration number (s) from the Customer Number indicated above:

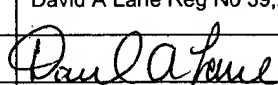
44133

50947

☐ Please add the following practitioner registration numbers to the Customer Number indicated above:

Additional practitioner registration numbers are listed on supplemental sheet(s) attached hereto

Request Submitted by:

Firm Name (if applicable)	Foley Hoag, LLP		
Name of Person submitting request	David A Lane Reg No 39,261		
Signature			
Telephone Number	1-617-832-1197	Date	5-29-02

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Box CN, Washington, DC 20231.



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov



CUSTOMER
NUMBER:
CORRESPONDENCE
ADDRESS:

FOLEY HOAG LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BOULEVARD
BOSTON, MA 02110-2600

FAX: 617-832-7000
E-MAIL: EKELLY@FHE.COM

PHONE: 617.823.1230

Date Mailed: 07/24/2002

NOTICE OF CUSTOMER NUMBER RECORD CHANGE

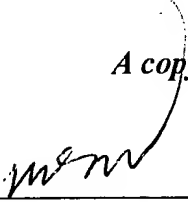
The request to change the information associated with the above-identified Customer Number has been accepted by the Commissioner of Patents and Trademarks.

The Customer Number may be used to identify the correspondence address or "fee address" for, and/or the appointed practitioner(s) in, a United States patent application or patent. The correspondence address and registration numbers indicated on this notice reflect the current correspondence address and registration numbers associated with the above-identified Customer Number.

PRACTITIONER REGISTRATION NUMBER(S) ASSIGNED TO THAT CUSTOMER NUMBER:

20407, 28129, 35153, 35430, 39261, 39329, 42049, 42461
42483, 42581, 42852, 43946, 44719, 46663, 46778, 46967
47172, 47326, 47416, 48440, 48543, 50356, 50558.

*A copy of this notice **MUST** be returned with the reply.*


Patents Electronic Business Center
(703) 305-3028

PART 1 - ATTORNEY/APPLICANT COPY

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Organization

UNITED STATES PATENT AND TRADEMARK OFFICE

P.O. Box 1450

Alexandria, VA. 22313-1450

If Undeliverable Return In Ten Days

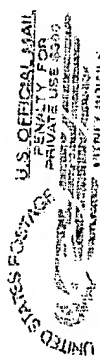
Official Business

Penalty For Private Use, \$300

REMPSEN - RETURN TO SENDER

Bldg./Room

AN EQUAL OPPORTUNITY EMPLOYER

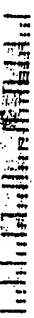


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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,654	09/27/2001	Aled Edwards	IPT-002.02	3485

7590

03/22/2004

Patent Group
Foley, Hoag & Eliot LLP
One Post Office Square
Boston, MA 02109-2170

EXAMINER

BORIN, MICHAEL L.

ART UNIT

PAPER NUMBER

1631

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding:

Office Action Summary

Application No.

09/965,654

Applicant(s)

EDWARDS ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 January 1943.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-43 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Part III DETAILED ACTION

Claims 1-43 are currently pending.

Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-22, drawn to method of data mining, classified in class 707, subclass 03.
- II. Claims 23-31, drawn to computer program product, classified in class 369, subclass 172.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as product and process of use. The method of Group I can be executed without the spevspecificgram of Group II by other means, e.g., by doing logic operations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

Species Requirement

Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims.(MPEP 808.01(a)).

This application contains claims directed to the following patentably distinct species of the claimed invention.

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(A) type of outcome (as in claims 2,3);

(B) a type of characteristics, as set forth in claims 12,14,16-20.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from group (A) and group (B) above for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 . If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is

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the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (571) 272-0722.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-0549.

MICHAEL BORIN, PH.D.
PRIMARY EXAMINER

March 18, 2004

mlb

